further showing to the contrary, Applicant has not failed to comply with Rule 98.

Rejection under Statutory Type Double Patenting

Claims 1, 2, 5-19, 26-29, 32, 39-44, 46, 53, 55-57 stand provisionally rejected under 35 U.S.C. § 101 as allegedly claiming the same invention as that of claims 1-39 of copending Application No. 09/334,130 ("the '130 application"). Applicant respectfully traverses this rejection, as the present claims and the claims of the '130 application are not drawn to identical subject matter.

Applicant's claims are not directed to the same subject matter as the claims of the '130 application. The Office Action states that the above claims of the present "application, are drawn to the genus of oligomeric compounds and oligonucleotides that are conjugated to an arylpropionic acid and that interact with a protein, and methods thereof; and so are obvious over the species of oligonucleotides covalently attached to an arylpropionic acid that interacts with a protein, and methods thereof, of claims 1-39 of" the '130 application (Office Action, at page 4). However, a rejection for statutory double patenting under 35 U.S.C. § 101 requires that two claims be drawn to the same invention. *See In re Longi*, 225 U.S.P.Q. 645, 648 (Fed. Cir. 1985). "Same invention" is defined as being identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1984); M.P.E.P. § 804. The rejected claims of the present application are not coextensive with the claims of the '130 application. The scope of the claims of the present application are broader than the scope of the '130 application. The Office Action has, therefore, failed to identify any pending claim that is identical in scope to a claim in the '130 application. Without such a showing, the present rejection should be

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need be included" as part of an information disclosure statement filed under 37 C.F.R. 1.97.

withdrawn.

Rejections under 35 U.S.C. § 112, first paragraph

Claims 1, 2, 5-19, 21-29, 31, 32, 34-44, 46, and 48-57 stand rejected as allegedly lacking written description. The Office Action, however, has not identified any aspect of the claimed inventions that lacks support in the specification as originally filed. Rather, this section of the Office Action alleges that Applicant's disclosure would be insufficient for those skilled in the art to practice the claimed inventions. For this reason, the Office Action's allegations are addressed below. Accordingly, the rejection for alleged lack of written description is improper and should be withdrawn.

Claims 1, 2, 5-19, 21-29, 31, 32, 34-44, 46, and 48-57 stand rejected because they allegedly contain subject matter that was not described in the specification in such a way as to enable one skilled in the art to make and/or use the claimed invention. Applicant respectfully traverses this rejection, as the Office Action has presented no adequate reason to believe that those skilled in the art would be unable to practice the claimed inventions.

The first paragraph of Section 112 requires that the disclosure of a patent application be such that persons skilled in the art, having read the patent application, would be able to practice the inventions described by the claims. *In re Wands*, 8 U.S.P.Q.2d 1400 (Fed. Cir. 1988). There is no legal requirement that this be done in any particular manner. An enabling disclosure can be provided by the use of illustrative examples or simply by broad terminology. *In re Marzocchi*, 169 U.S.P.Q. 367 (C.C.P.A. 1971).

When rejecting a claim under the enablement requirement of Section 112, the Patent Office bears the "initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by that claim is not adequately enabled by the description of the invention provided in the specification." *In re Wright*, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993). To object to a specification on the grounds that the disclosure is not enabling with respect to the scope of a claim sought to be patented, the Office Action must identify evidence or technical reasoning substantiating those doubts. *Id.*; and M.P.E.P. § 2164.04. Without a reason to doubt the truth of the statements made in the patent application, the application must be considered enabling. *In re Wright*, 27 U.S.P.Q.2d at 1513; *In re Marzocchi*, 169 U.S.P.Q. 367, 369.

There is no evidence of record indicating a reason to doubt that the Applicant's disclosure would enable those skilled in the art to practice the claimed invention. Although the Office Action argues that the specification does not provide particular guidance for the entire class of arylpropionic acids as used in the present invention, it has failed to provide any supporting evidence. There is no evidence of record that one skilled in the art would not be able to practice the claimed invention at least to some measurable extent. The Office Action seemingly requires that Applicant provide examples for each and every arylpropionic acid. However, the Office Action has yet to establish why some arylpropionic acids are enabled, while others are not. Even in the unpredictable arts, mere statements by the Examiner as to the absence of additional working examples is insufficient to compel a conclusion of nonenablement. *In re Colianni*, 668 F.2d 1229 (C.C.P.A. 1982). Applicant is not required to disclose every use proposed in their disclosure, as compliance with 35 U.S.C. § 112, first paragraph does not turn on whether each example of a particular use is disclosed. M.P.E.P.

§ 2164.02. As such, the rejection under Section 112, first paragraph should be withdrawn.

Rejections under 35 U.S.C. § 102

Claims 1, 2, 7-11, 14-19, 21, 26-28, 34, 39, 40, 41, 42, 55, and 56 stand rejected as allegedly being anticipated by Hale et al., U.S. Patent No. 5,607,691 ("the Hale patent"). Applicant traverses this rejection as the Hale patent does not anticipate the claimed invention because it does not "teach each and every element as set forth in the claim[s]" either expressly or inherently. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

One skilled in the art would not recognize the present invention as being taught by the Hale patent. The Hale patent discloses compounds having the generic framework of a pharmaceutical agent (A), a chemical modifier (B), and a functionality modifier (C). There are listed many options for what can be a pharmaceutical agent as well as a plethora of compounds for chemical and functionality modifiers. The Office Action notes the presence of naproxen and oligonucleotides. However, it must do more than merely point out the presence of each element of the present invention within the myriad of compounds listed. As such, the Office Action fails to show how the Hale patent would have taught one skilled in the art to use oligonucleotides and arylpropionic acids as claimed in the present invention without the presence of Applicants' disclosure. *In re Ruschig*, 343 F.2d 965, 974, 145 U.S.P.Q. 274, 282 (Fed. Cir. 1965) (Board's finding of anticipation overturned because Board improperly engaged in "mechanistic dissection and recombination" of components of illustrative compounds in disclosed reference to "create hindsight anticipation[] with the guidance of an applicant's disclosures.").

Rejections under 35 U.S.C. § 103(a)

Claims 1, 2, 7-11, 14-17, 21, 26-28, 34, 39-41, 55 and 56 stand rejected as allegedly being unpatentable over Hale and further in view of Blaschke et al, U.S. Patent No. 4,973,745, Herve et al., Clin. Pharmacokinetic. 26 (1): 44-58,1994, Lagrange et al., Fundam. Clin. Pharmacol. 1998:12: 286-291, and applicant's admission at page 14, line 21-page 15, line 3 of the present specification. Applicant respectfully traverses this rejection.

Patent claims cannot be found obvious in view of a combination of references unless the prior art itself suggests the desirability of the combination. *Berghauser v. Dann*, 204 U.S.P.Q. 393 (D.D.C. 1979); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929 (Fed. Cir. 1984). "A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field." *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000). To establish a *prima facie* case of obviousness, "there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant." *In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q.2d 1635, 1637 (Fed. Cir. 1998). "In other words, the examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

The Office Action has failed to show any motivation for one skilled in the art to modify the teaching of Hale to obtain the claimed invention. As discussed above, the Hale patent discloses a great number of choices for use in its generic framework, including an oligonucleotide and naproxen. However, the mere presence of these two aspects is not enough to show obviousness. *In re Baird*, 16 F.3d 380, 382, 29 U.S.P.Q.2d 1550, 1552 (Fed. Cir. 1994) ("The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious."); *In re Jones*, 21 U.S.P.Q.2d 1941, 1943 (Fed. Cir. 1992) (rejecting Commissioner's argument that "regardless [] how broad, a disclosure of a chemical genus renders obvious any species that happens to fall within it"). The Office Action fails to explain why a person of ordinary skill would have been motivated to choose an oligonucleotide and naproxen rather than the many other pharmaceutical agents and functionality modifiers of the Hale patent. To the extent that the Office Action alleges that such motivation is provided by a statement in the Hale patent concerning extension of the excretion half-life of a pharmaceutical agent (Office Action, at page 14), Applicant notes that such statements relate to the functionality modifiers disclosed in the reference and not to all arylpropionic acids. Absent some reason why those skilled in the art would have been motivated to practice the claimed invention – as opposed to one of the many other compounds that conceivably could have been produced by the Hale patent – the rejection for alleged obviousness is improper and should be withdrawn.

To the extent that the Hale patent has been combined with the Blaschke patent because of its teaching regarding arylpropionic acids, such a combination is untenable because it is based on

conclusory reasoning, and not on the teachings of the cited documents. The Blaschke patent contains no suggestion that arylpropionic acids are useful as functionality modifiers as used in the Hale patent. Finding no suggestion, it appears that the Office Action used the Applicant's disclosure as a guide instead of factual evidence. The Patent Office has the burden of presenting factual evidence that would indicate that the claimed methods are *prima facie* obvious. *In re Lunsford*, 148 U.S.P.Q. 721 (C.C.P.A. 1966). In the absence of such a showing, such a rejection is based upon impermissible hindsight. *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992) ("it is impermissible for an Examiner, in proffering a 35 U.S.C. § 103 rejection, to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art to render the claimed invention obvious."). Thus, neither the Hale nor the Blaschke patents, nor any of the other cited references, teach or suggest to those skilled in the art that the teachings of the Hale patent could be modified in such a way as to obtain Applicant's claimed invention.

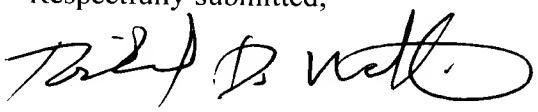
Claims 18 and 19 stand rejected as allegedly being unpatentable over the Hale patent as applied to claims 1, 2, 5-11, 13-17, 20-23, 25-30, 33, 34, 37-39 above and further in view of Baker et al., U.S. Patent No. 5,789,573. As discussed above, the Hale patent, either alone or in combination with the other cited references, does not render the current invention unpatentable. Applicant respectfully requests withdrawal of this rejection.

Conclusion

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned **"Version with markings to show changes made."**

Applicant believes that the foregoing constitutes a complete and full response to the Office Action of record. Applicant respectfully submits that this application is now in condition for allowance. Accordingly, an indication of allowability and an early Notice of Allowance are respectfully requested.

Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the specification:

On page 1, line 2, before "Field of Invention," a new paragraph entitled "CROSS-REFERENCE TO RELATED APPLICATIONS" was added.

In the claims:

Please amend the claims as follows:

31. (**amended**) The method of claim 26 wherein said arylpropionic acid is ibuprofen.

35. (**amended**) The [oligomeric compound] method of claim 34 wherein said arylpropionic acid is chiral.

36. (**amended**) The [oligomeric compound] method of claim 35 wherein said chiral arylpropionic acid has the S configuration.

37. (**amended**) The [oligomeric compound] method of claim 35 wherein said chiral arylpropionic acid has the R configuration.

38. (**amended**) The [oligomeric compound] method of claim 34 wherein said aryl groups are substituted or unsubstituted benzyl, phenyl, xylyl, naphthyl, toluyl, pyrenyl, anthracyl, phenanthryl, azulyl, phenethyl, cinnamyl, benzhydryl, and mesityl wherein said substituents are hydroxyl, alkyl, alkoxy, alcohol, benzyl, phenyl, nitro, thiol, thioalkoxy, halogen, or alkyl, substituted alkyl, aryl, alkenyl, or alkynyl groups.

49. (**amended**) The [oligomeric compound] method of claim 48 wherein said arylpropionic acid

is chiral.

50. (**amended**) The [oligomeric compound] method of claim 49 wherein said chiral arylpropionic acid has the S configuration.

51. (**amended**) The [oligomeric compound] method of claim 49 wherein said chiral arylpropionic acid has the R configuration.

52. (**amended**) The [oligomeric compound] method of claim 48 wherein said aryl groups are substituted or unsubstituted benzyl, phenyl, xylyl, naphthyl, toluyl, pyrenyl, anthracyl, phenanthryl, azulyl, phenethyl, cinnamyl, benzhydryl, and mesityl wherein said substituents are hydroxyl, alkyl, alkoxy, alcohol, benzyl, phenyl, nitro, thiol, thioalkoxy, halogen, or alkyl, substituted alkyl, aryl, alkenyl, or alkynyl groups.